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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,826	10/15/2001	George Goicoechea	BSI-010US4	4645

7590 08/22/2007  
Ratner & Prestia  
One Westlakes, Berwyn, Suite 301  
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Valley Forge, PA 19482

EXAMINER
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MATTHEWS, WILLIAM H

ART UNIT	PAPER NUMBER
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3738

MAIL DATE	DELIVERY MODE
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08/22/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/977,826

Applicant(s)

GOICOECHEA ET AL.

Examiner

William H. Matthews (Howie)

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20,22-41,43-49 and 54-62 is/are pending in the application.
- 4a) Of the above claim(s) 26,34-38,40 and 58-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20,22-25,27-33,39,41,43-49 and 54-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7-16-07.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 8-8-07 have been fully considered but they are not persuasive.
2. Regarding the rejection under 35 USC 112 of claims 56 and 57, Applicant contends support is provided at p68 lines 7-8, p 44 lines 19-23, and "figures of the application". Applicant did not specify which "figures", and Examiner is unaware of a figure providing support for claims 56 and 57. Examiner disagrees with Applicant's position because the specification only provides support for each hoop being "substantially perpendicular" in combination with hoops having vertices connected to vertices of an adjacent hoop. This is described in connection with figures 1-4 at page 23 lines 20-23, in the current abstract, as amended on 3-1-02, and in claim 18 as originally filed. Page 44, lines 19-23 describes figures 22-23 and only state that "one or more hoops" are perpendicular rather than each or all hoops.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 20,22-25,27-33,39,41,43-49,54-57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

5. Claims 20,22-25,27-33,39,41,43-49,54-57 are rejected because independent claims 54 and 56 each recite vertices that abut which is not disclosed in the specification. The specification only disclose juxtaposed vertices. Juxtapose is defined by Merriam Webster's Collegiate Dictionary, 10<sup>th</sup> Ed. as: to place side by side and synonymous with "adjacent". Adjacent is described as: may or may not imply contact , but always implies absence of anything of the same kind in between.

6. Claims 20,22-25,27-33,39,41,43-49,54-55 are rejected because independent claim 54 recites "non-helical" in combination with each hoop being substantially perpendicular and having connected apices. The specification only disclose embodiments wherein each hoop is substantially perpendicular and has connected apices and has a helical "offset" feature.

7. Claims 56-57 recite "the vertices of each hoop pointed in the axial direction lie in a common plane perpendicular to the longitudinal axis of the tubular member" in combination with axially abutting vertices of adjacent hoops, which is not disclosed in the specification. The specification do provide support for the phrase "substantially perpendicular" for the combination, and "perpendicular" for the straight stents of figures 22-23 but only for "one or more" rather than each or all hoops. This is also supported by original claim 18, the description of figures 1-4, and the amended abstract of 3-1-02.

8. With further regard to claim 56, Applicant's arguments regarding the subject matter of page 68 (abstract) are moot because that abstract was replaced on 3-1-02.

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Furthermore, it is noted that in the parent application (08/312,881), the abstract did not contain the limitations Applicant relies on in the arguments (remarks, page 8). Because the specification fail to support the combination (perpendicular and connected abutting apices), the abstract as originally filed on page 68 of the current application appear to contain new matter as compared to the parent application, 08/312,881.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Matthews (Howie) whose telephone number is 571-272-4753. The examiner can normally be reached on Monday-Friday 10-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M. McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William H. Matthews/  
Primary Examiner  
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